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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,060	07/09/2001	Roger Collins	05545.P001	9276

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EXAMINER

WAMSLEY, PATRICK G

ART UNIT PAPER NUMBER

2819

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/902,060

Applicant(s)

COLLINS ET AL.

Examiner

Patrick G Wamsley

Art Unit

2819

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11,13-19,21 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,13-19,21 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 11, 13, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 806,858 to Szlam, hereafter Szlam.

For claim 1, Szlam provides a method comprising the steps of identifying a block of data within an electronic mail message [Szlam's method includes e-mail as well as other data formats] also found in a stored message; generating a pointer [see col. 14, lines 19-32]; replacing the block of data with the pointer [this occurs when Szlam creates a Composite Call Object <sup>TM</sup>]; and transmitting the message to a wireless device [Szlam lists numerous methods of communication, including wireless] having a stored message [pointers identify data used during prior communication transactions]. Claim 11 restates these limitations in system format. For claim 21, Szlam replaces data blocks with pointers to achieve more efficient transmission of information.

For claims 3, 13, and 24, Szlam decompresses e-mail by inserting blocks of data corresponding to specified pointers.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4-9, 14-19, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art, hereafter APA, in view of Szlam.

APA is hereby defined as conventional e-mail techniques presented in the disclosure. For claims 4, 14, and 25, prior art e-mail includes subject fields. For claims 5, 15, and 26, conventional e-mail designates responses to previous e-mails [typically with RE:]. For claims 6, 16, and 27, one or more alternate compression techniques are applied to conventional e-mail, as described on pages 2-3. For claims 7, 17, and 28, it's well known to replace common strings with code words; applicant describes LZW compression with pointers on page 3. For claims 8, 18, and 29, conventional e-mails include address domains. For claims 9, 19, and 30, the use of six bits per character appears to be conventional. No critical reason for the selection of this number of bits has been presented.

APA lacks the concept of generating a pointer identifying data blocks in previous e-mails, replacing blocks with that pointer, and then transmitting the message to a wireless device storing the previous e-mails. As described for the 102 rejection above, Szlam provides these features. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have applied Szlam's teachings to APA. The motivation would have been to provide data compression, as described by Szlam on lines 37-48 of column 3.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,507,643 to Groner uses prior message files to compress subsequent e-mails. U.S. Patent 6,510,453 to Apfel et al inserts data fragments into e-mails based upon stored identifiers.

Art Unit: 2819

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick G. Wamsley whose telephone number is (703) 305-3504. Send facsimiles to (703) 872-9306 or (703) 746-8802.

*Patrick G. Wamsley*  
Patrick G. Wamsley

November 12, 2003